

REMARKS/ARGUMENTS***The Restriction Requirement***

The Office Action sets forth a restriction requirement between the following groups of claims: (I) claims 1-12 (drawn to a soft-focus cosmetic composition comprising fumed alumina particles), (II) claims 13-24 (drawn to a method of enhancing the soft-focus effect of a cosmetic composition comprising combining the cosmetic composition with fumed alumina particles), and (III) claims 25-36 (drawn to a method of disguising skin imperfections comprising applying a cosmetic composition comprising fumed alumina particles).

Applicants' Election

In response to the restriction requirement, Applicants elect, with traverse, the invention of Group I (i.e., claims 1-12) for further prosecution. Applicants respectfully submit that the restriction requirement is improper for the reasons set forth herein and, therefore, request withdrawal of the restriction requirement.

Discussion of Restriction Requirement

The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states that there are two criteria for proper restriction between patentably distinct inventions: (a) the inventions must be independent or distinct, *and* (b) there must be a serious burden on the examiner in the absence of restriction (see M.P.E.P. § 803). These are two separate criteria that must be satisfied to support a proper restriction requirement. That both criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.: “If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions” (M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine

all of the pending claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

Applicants respectfully submit that the restriction requirement as between the claims of Groups I, II, and III is improper because the nature of the claims is such that any burden encountered in searching the groups together would, at most, be slight (and certainly not “serious”).

In this respect, the claims of Group I (claims 1-12) are directed to a soft-focus cosmetic composition. The claims of Group II (claims 13-24) are directed to a method of enhancing the soft-focus effect of a cosmetic composition by forming the cosmetic composition of the claims of Group I. The claims of Group III (claims 25-36) are directed to a method for disguising skin imperfections comprising the use of the cosmetic composition of the claims of Group I. If the composition claims of elected Group I are determined to be patentable, then the use thereof as recited in the claims of Groups II and III must be novel and unobvious. Additionally, and as acknowledged by the Office Action, Groups I, II, and III are of the same search class. As such, any search and consideration of the claimed subject matter of Group I will necessarily overlap the search and consideration of the claimed subject matter of Groups II and III. Similarly, any search and consideration of the claimed subject matter of Group II will necessarily overlap the search and consideration of the claimed subject matter of Groups III.

The similarity of the subject matter encompassed by the pending claims means that there would be no serious burden on the Examiner to search and examine all of the subject matter encompassed by the pending claims at the same time.

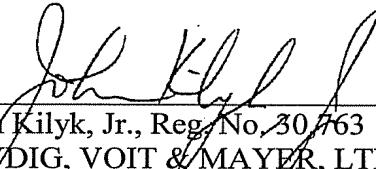
Accordingly, Applicants respectfully request withdrawal of the restriction requirement.

In any event, Applicants reserve the right to seek rejoinder of any non-examined claims upon an indication of the allowability of any of the examined claims to the extent such non-examined claims are dependent upon, or include the limitations of, any of the allowed claims.

Conclusion

Applicants respectfully request withdrawal of the restriction requirement. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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